

REMARKS

The applicant has carefully considered the final official action dated November 1, 2004, and the references it cites. In the official action, claims 1, 2, 4-6, and 8-11 were rejected under 35 U.S.C. § 102 as anticipated by DeBruin-Ashton. Additionally, claims 3 and 7 were rejected under 35 U.S.C § 103(a) as unpatentable over DeBruin-Ashton in view of Manley et al. Claim 11 has been amended to correct a minor typographical error. In view of the following remarks, it is respectfully submitted that pending claims 1-11 are in condition for allowance. The applicant respectfully requests reconsideration of this application.

The applicant respectfully submits that independent claim 1 is allowable over the art of record. In particular, the official action incorrectly contends that DeBruin-Ashton teaches creating first and second brochure version templates, printing a first brochure version by calling up the first brochure version template, and printing a second brochure version by calling up the second brochure version template. In fact, the examiner has completely failed to make a prima facie rejection of claim 1 because he has failed to provide any evidence whatsoever of how DeBruin-Ashton teaches first and second brochure version templates. If the examiner wishes to maintain his apparent contention that DeBruin-Ashton discloses first and second brochure version templates as recited in claim 1, the applicant respectfully requests that at least some evidence that DeBruin-Ashton provides such a teaching be identified. If the examiner fails to provide such evidence, he must withdraw the rejections of claims 1, 2, 4-6, and 8-11 as anticipated by DeBruin-Ashton.

Moreover, the applicant respectfully submits that DeBruin-Ashton does not teach or even suggest first and second brochure version templates. Instead, DeBruin-Ashton teaches creating one directory template (column 9, lines 66-67) that is used for every subscriber and retrieving the same directory template after each directory is printed (column 13, lines 45-

47), but in no way teaches or suggests using any other directory template. On the contrary, DeBruin-Ashton fails to recognize any advantage of creating a plurality of directory templates, each of which may correspond to a group of subscribers having at least some common characteristics even though DeBruin-Ashton seems to recognize that some subscribers have common characteristics (column 12, lines 4-9). Instead, DeBruin-Ashton teaches producing each directory by repeatedly running the same directory template through the same sequence of customization operations (FIGS. 2A – 2C) for each subscriber regardless of whether some of the directories end up having the same variable information. Accordingly, the applicant respectfully submits that independent claim 1 and claims 2-4 dependent thereon are in condition for allowance.

The applicant respectfully submits that independent claim 5 is also allowable over the art of record. In particular, independent claim 5 recites attaching a printed brochure to a periodical. The language of claim 5 makes it clear that the printed brochure and the periodical are independent entities that are attached to one another after the brochure is printed. The examiner contends that the directories taught by DeBruin-Ashton are periodicals, that photographs and maps are brochures, and that electronically merging the photographs and maps with a directory template to form the directories (column 13, lines 39-43) constitutes attaching a printed brochure to a respective periodical as recited in claim 5. However, the examiner's contention ignores the language set forth in claim 5 that requires attaching a printed brochure to a respective periodical. Instead, the examiner has incorrectly construed an electronic merging of data as taught by DeBruin-Ashton to be the same as attaching a printed brochure to a respective periodical as recited in claim 5. One of ordinary skill in the art will readily appreciate that electronically merging data cannot be construed to mean attaching a printed structure to another structure because electronic data is not the same as printed information.

Further, a correct interpretation of DeBruin-Ashton clearly indicates that DeBruin-Ashton does not teach or even suggest printing photographs and maps as a printed brochure independent of a periodical, much less attaching the printed brochure to the periodical as recited in claim 5. Any suggestion that DeBruin-Ashton teaches or suggests printing a brochure independent of a directory and attaching the printed brochure to the directory is completely unfounded. Instead, as set forth in column 13, lines 39-43, DeBruin-Ashton teaches electronically merging the directory template and variable print information (physician names, photographs, maps, etc.), which are then printed to form a printed directory. In other words, DeBruin-Ashton teaches first electronically merging information and then printing all of the information including the photographs and maps as part of the directory and, thus, does not teach printing the photographs and maps as a printed brochure independent of the directory. Moreover, DeBruin-Ashton teaches that the entire directory is a brochure (column 10, lines 40-42), which is totally contrary to the examiner's apparent contention that DeBruin-Ashton teaches attaching a printed brochure to a periodical as recited in claim 5. Accordingly, the applicant respectfully submits that independent claim 5 and claims 6-8 dependent thereon are in condition for allowance.

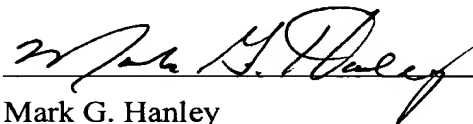
The applicant respectfully submits that independent claim 9 is also allowable over the art of record. In particular, the examiner has again failed to make a prima facie rejection based on the language of the claim. Specifically, independent claim 9 recites, *inter-alia*, "selecting at least one qualifying criteria ... related to credit histories..." and "... accessing a database of credit histories..." DeBruin-Ashton does not teach or suggest using criteria related to credit histories or accessing a database of credit histories. On the contrary, DeBruin-Ashton teaches accessing customer names, medical-related characteristics, and physician names. The examiner's rejection of claim 9 provides nothing regarding the credit history language of claim 9.

Claim 9 also recites a brochure version including a pre-approved activation coupon for a product or service. DeBruin-Ashton does not teach or suggest any type of pre-approved activation coupon. Nor would it be obvious to combine a pre-approved activation coupon with the teachings of DeBruin-Ashton. First, DeBruin-Ashton does not teach any product or service for which a pre-approved activation coupon is required. Second, unlike claim 9, in which the pre-approved activation coupon may be pre-approved based on a credit history of a subscriber, DeBruin-Ashton does not teach any criteria upon which pre-approval of an activation coupon can be based. Accordingly, the applicant respectfully submits that independent claim 9 and claims 10-11 dependent thereon are in condition for allowance.

Further, none of the other references cited in the official action overcome the above-noted deficiencies of DeBruin-Ashton. Accordingly, the applicant respectfully submits that independent claims 1, 5, 9, and all claims dependent thereon are in condition for allowance.

In view of the foregoing, the applicant respectfully submits that this application is in condition for allowance. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



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